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particle size of not more than 320.1 nm, wherein a solid content is from 30 to 50 % by weight, and a content of a fluorine-containing surfactant is not more than 1% by weight on the basis of water.✓

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#### REMARKS

Claim 1 has been amended above by inserting the limitation of an average particle size of not more than 320.1 nm. This aspect of applicant's claimed invention is described in Comparative Example 4 shown in Table 1 on page 13 of applicant's specification. Claims 1 and 6 remain in the application for consideration by the Examiner.

Applicant respectfully requests that the foregoing amendment to Claim 1 be entered under the provisions of 37 C.F. 1.116(b) for the purposes of placing the application and condition for allowance or for the purposes of appeal. The outstanding Office Action set forth a rejection of Claim 1 over prior art that was not set forth in the previous Office Action. The foregoing amendment to Claim 1 has been made a response to this new prior art rejection. Since the prior art rejection was newly made in the outstanding Office Action, prior to this time, applicant could not amend Claim 1 in response thereto.

For the foregoing reasons applicant respectfully requests that the amendment to Claim 1 be entered under the provisions of 37 C.F. 1.116(b) for the purposes of placing the application in condition for allowance or for the purposes of appeal.

Claim 6 was rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Official Action stated that there is nothing in the specification about diluting the reaction product of Comparative Example No. 5 and recondensing it to yield an emulsion containing less than 1% surfactant. The Official Action commented that the Tsuda declaration does not show how to produce particles having an average particle size of less than 200 nm with the use of less than 1% fluorinated surfactant, because the particles are produced with 2% surfactant and kept in suspension with 0.78% surfactant. The Official Action concluded that the declaration is new matter and has no probative value.

Applicant respectfully submits that the present specification provides a written description of Claim 6 and would enable one of ordinary skill in the art to make and use the invention defined in Claim 6 within the meaning of 35 U.S.C. §112, first paragraph.

The applicant understands the final Office Action to take the position that applicant's specification did not comply with the description requirement and not that applicant's specification does not comply with the enablement requirement of 35 U.S.C. §112, first paragraph. The courts have long and clearly recognized that there is a description of the invention requirement in 35 U.S.C. §112, first paragraph, separate and distinct from the enablement requirement. *In re Bowen*, 181 USPQ 48 (CCPA 1974); *In re Smith*, 178 USPQ 620 (CCPA 1973); *In re Moore*, 169 USPQ 236 (CCPA 1971). Thus, the first paragraph of 35 U.S.C. § 112 contains separate requirements for:

a description [1] of the invention, and [2] of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same . . . .

Applicant respectfully submits that the present specification complies with both the (1) written description of the invention and (2) enabling disclosure requirements of the first paragraph 35 U.S.C. § 112. As far as the written description of the invention, applicant respectfully submits that the statements in the specification at, page 3, line 34, through page 4, line 4, and page 4, lines 7-12, which describe the use of only a fluorine-containing surfactant in the amount of not more than 1% by weight on the basis of water, provide a written description of the invention that corresponds to Claim 6. In

particular, this portion of applicant's specification describes that the problems in the prior art have been solved by providing an aqueous dispersion of fluorine-containing polymer, which comprises a vinylidene fluoride polymer having a particle size as small as not more than 200 nm, contains solids in an amount as high as 30 to 50% by weight and has a surfactant in an amount as low as not more than 1% by weight on the basis of water, and the surfactant is a fluorine-containing surfactant. This is all that Claim 6 requires. Thus, applicant's specification provides a written description of the invention as set forth in Claim 6.

It is respectfully noted that the description of the invention has nothing to do with how to make and use the invention. The Tsuda declaration, which was attached to applicant's previous response, shows how to make and use the invention, but the applicant is not claiming a process of producing such particles - only the particles in dispersion with 1% or less of a fluorine-containing surfactant. Thus, it is not necessary that the applicant's specification describe such a method. The Tsuda declaration was simply provided to demonstrate the feasibility of the claimed invention.

For the foregoing reasons, applicant respectfully submits that the present specification disclosure conveys that the present applicant had possession of the claimed invention at the time this application was filed within

the meaning of 35 U.S.C. 112, first paragraph. Therefore, applicant respectfully requests the Examiner reconsider and withdraw this rejection.

Claim 1 was rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 3,708,463 of Stallings in view of U.S. Patent No. 4,025,709 of Blaise *et al.* (Blaise). The Official Action stated that Stallings discloses a process for preparing vinylidene fluoride homopolymer (Claim 1) using 0.1% to 1.5% fluorinated surfactant (Claim 5), preferably 0.5 - 1.0% (column 4, lines 15-17), based on the monomer. The Official Action continued that in Example 1 the fluorinated surfactant concentration on the basis of water is 0.85%. The Official Action further stated that the latex contains 825 grams of solids. With respect to Blaise, the Official Action stated that these teachings use 2.4 grams of fluorinated emulsifier in 2 liters of water and a latex containing 35% solids, noting Examples 6 and 7.

Applicant respectfully submits that the teachings of Stallings or Blaise did not disclose or suggest the invention as set forth in the present claims within the meaning of 35 U.S.C. 102 or 35 U.S.C. 103.

The applicant can find no discussion in the teachings of Stallings concerning the amount of solids proposed therein. Thus, the teachings of Stallings cannot disclose or suggest this aspect of the presently claimed

invention. While the dry polymer recovered may contain 825 grams (over 90% monomer conversion), as discussed at column 6, lines 21-22, of Stallings, it is respectfully noted that during the processing according to Example 1 of Stallings, 3140 grams of water are used and 908 grams of beginning monomer are used, together with other additives. Accordingly, the resulting 825 grams of polymer represents a solid contents [less than  $825/3140=26\%$ ], which is significantly less than that [30%] set forth in the present claim. Accordingly, the teachings of Stallings cannot contemplate or suggest the solid contents as required in applicant's claims.

The teachings of Blaise proposed a latex having a concentration and polymer equal to 35% by weight. However, no particle size is described in these teachings. As described in applicant's specifications, the particle size of the emulsion-polymerized PVdF polymer becomes smaller within the increase of amount of surfactant and with a decrease in polymer (solids) contents. Thus, in the prior art it was difficult to obtain a dispersion having both high solids content and small particle size.

Since the teachings of Blaise proposed the use of an amount of surfactant in excess of that set forth in the present claims, applicant respectfully submits that such teachings cannot contemplate or suggest a particle size and a solids content within the range set forth in the present

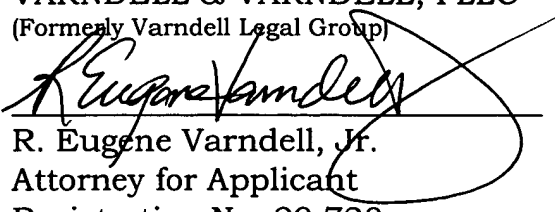
claims, namely, an average particle size of not more than 320.1 nm and a solids content of 30 to 50% by weight.

For the foregoing reasons, applicant respectfully submits that the presently claimed invention is distinguishable from the teachings of Stallings and Blaise. Therefore, applicant respectfully requests the Examiner reconsider and withdraw this rejection.

While it is believed that the present response places the application in condition for allowance, should the Examiner have any comments or questions, it is respectfully requested that the undersigned be telephoned at the below listed number to resolve any outstanding issues.

In the event this paper is not timely filed, applicant hereby petitions for an appropriate extension of time. The fee therefor, as well as any other fees which may become due, may be charged to our Deposit Account No. 22-0256.

Respectfully submitted,  
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